



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/760,113	01/12/2001	Barrett Toan	C18497/106453	1973

7590 02/09/2007
Robert G. Lancaster, Esq.
BRYAN CAVE LLP
One Metropolitan Square
211 North Broadway, Suite 3600
St. Louis, MO 63102-2750

EXAMINER

PORTER, RACHEL L

ART UNIT	PAPER NUMBER
----------	--------------

3626

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/760,113

Applicant(s)

TOAN ET AL.

Examiner

Rachel L. Porter

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 9/15/06. Claims 1-17 are pending.

Oath/Declaration

2. The objection to the oath is hereby withdrawn due to new oath filed 9/15/06.

Claim Rejections - 35 USC § 112

3. The rejections of claims 1-11 and 15-17 under 35 U.S.C. 112, second paragraph, as being indefinite, is hereby withdrawn due to the amendment filed 9/15/06.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-2, and 9-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Hyman (USPN 6,092,047).

[claim 1] Hyman discloses a method for using a computer apparatus for evaluating a plurality of plan design options that can be incorporated into a benefit plan offered to a

Art Unit: 3626

given participant population by comparing the cost of providing each option to the benefits of such option perceived by a group of one or more subjects, (see abstract) the method comprising the steps of:

- inputting the identification of the plan design options and a reference plan design option and the cost of providing each option (Figure 2A-2B; col. 5, lines 40-59; col. 6, lines 58-65) into the computer apparatus comprising an input device for receiving input data, the computer apparatus having an input device for receiving input data, a memory device for connected to the input device for storing the input data, a processor connected to the memory device which is programmed to perform operations upon the stored data to produce output data, and an output device connected to the processor for displaying the output data, (Figures 1A-B; col. 5, 31-39)
- providing the subject group with information about each plan design option and inquiries to elicit responses comparing each plan design option to the reference plan design option; (col. 5, lines 45-49; col. 6, lines 8-46; col. 7, lines 29-32)
- inputting data representative of the subject group responses; (col. 5, lines 45-49; col. 7, lines 54-66)
- calculating the average perceived benefit for each plan design option relative to the perceived benefit for the reference plan design option; (Figure 2B; col. 7, line 64-col. 8, line 10; col. 9, lines 30-48)
- dividing the cost of providing each option by the calculated average perceived benefit for such option; and (col. 8, lines 7-10; col. 9, lines 30-48)

- outputting the calculated data. (col. 8, lines 7-10)

[claim 2] Hyman discloses the method of claim 1 wherein the subject group is comprised of members of the participant population. (col. 8, lines 2-6)

[claim 9] Hyman discloses the method of claim 1 wherein the subject group is comprised of one participant (col. 8, lines 2-6). The preamble recites the transitional phrase/term "comprises," which "is inclusive or open-ended and does not exclude additional, unrecited elements or method steps." See MPEP 2111.03. As such, the Examiner interprets this claim to mean that the group includes "at least one participant."

[claim 10] Hyman disclose a method further comprising the step of inputting the identification of the plan design options incorporated in a given plan design (Figure 2B, col. 8, line 7- col. 9, line 55) and wherein the step of outputting the calculated data comprises identifying the output data which relate to the plan design options incorporated in the given plan design. (Figure 2B, Figures 3A-3B; col. 10, line 51-col. 11, line 48; col. 12, line 38-col. 13, line1)

[claim 11] Hyman discloses a method wherein the responses of the subject group comprise data representing each subject's assessment of a plurality of benefit criteria for each plan design option compared to the reference plan design option (Figure 2B,

Art Unit: 3626

col. 8, line 7- col. 9, line 55) and wherein each subject's perceived benefit for each plan design option is determined according to a relative weight defined by the subject for each specific benefit criterion. (Figures 3A-3B; col. 10, line 51-col. 11, line 48; col. 12, line 38-col. 13, line 1)

[claim 12] Hyman discloses the method of claim 11 further comprising the step of inputting values for at least one statistical factor related to each plan design option (Figure 2B; col. 8, lines 7-65; Figure 3A) and wherein each subject's perceived benefit for each plan design option comprises the product of a relative weight defined by the subject to be accorded each statistical factor multiplied by the value of such statistical factor for such plan design option. (Figure 3B; col. 14, lines 28-col. 15, line 12)

[claim 13] Hyman discloses a computer based system for evaluating a plurality of plan design options that can be incorporated into a benefit plan offered to a given participant population by comparing the cost of providing each option to the benefits of such option perceived by a group of subjects, the system comprising:

- an input device for receiving input data, (Figure 1A; col. 5, lines 27-39)
- a memory device connected to the input device for storing the input data, (Figures 1A-B; col. 5, lines 27-39)
- a processor connected to the memory device which is programmed to perform operations upon stored data to produce output data, and (Figures 1A-B; col. 5, lines 27-39)

- an output device connected to the processor for displaying the output data (Figures 1A-B; col. 5, lines 27-39)
- the input device capable of receiving data representing the identification of the plan design options, the reference plan design option, the cost of providing each option (Figure 2A-2B; col. 5, lines 40-59; col. 6, lines 58-65) and responses of the subject group to inquiries comparing each plan design option to the reference plan design option; (col. 5, lines 45-49; col. 7, lines 54-66)
- and the processor programmed for calculating the average perceived benefit for each plan design option relative to the perceived benefit for the reference plan design option (Figure 2B; col. 7, line 64-col. 8, line 10; col. 9, lines 30-48) and dividing the cost of providing each option by the calculated average perceived benefit for such option. (col. 8, lines 7-10; col. 9, lines 30-48)

[claim 14] Hyman discloses a method in which the group members are repeatedly surveyed to determine which whether the employees with opt down or opt out of certain benefits. (i.e. readministering inquiries to the subject group to elicit revised responses comparing each plan design option to the reference plan design option) (col. 7, lines 29-35; lines 54-59) and wherein the input device is capable device receiving this information. Hyman further discloses inputting data representing revised responses of the subject group to the inquiries (col. 7, lines 59-63) and using this revised response data to calculate that average perceived benefit of each design option. (col. 7, lines 64-col. 8, line 6; col. 8, line 60-col. 9, line 25).

Art Unit: 3626

[claim 15] Hyman discloses a method for using a computer apparatus for evaluating a plurality of plan design options that can be incorporated into a benefit plan offered to a given participant population by comparing the cost of providing each option to the benefits of each option perceived by a group of one or more subjects, (See Abstract)

the method comprising the steps of:

- inputting the identification of the plan design options, values for each of a plurality of statistical factors related to each plan design option, and the cost of providing each option, (Figure 2A-2B; col. 5, lines 40-59; col. 6, lines 8-65) into the computer apparatus comprising an input device for receiving input data, a memory device connected to the input device for storing the input data, a processor connected to the memory device which is programmed to perform operations upon the stored data to produce output data, and an output device connected to the processor for displaying the output data, (Figures 1A-B; col. 5, 31-39)
- providing the subject group with information about each statistical factor and inquiries to elicit responses providing the relative weight of each statistical factor to be used in determining the perceived benefit of the plan design options; (col. 5, lines 45-49; col. 6, lines 8-46; col. 7, lines 29-32)
- inputting data representative of the subject group responses; (col. 5, lines 45-49; col. 6, lines 8-46; col. 7, lines 29-32)
- calculating the average perceived benefit for each plan design option; (Figure 2B; col. 7, line 64-col. 8, line 10; col. 9, lines 30-48)

Art Unit: 3626

- dividing the cost of providing each option by the calculated average perceived benefit for such option; (col. 8, lines 7-10; col. 9, lines 30-48)
- and outputting the calculated data. (col. 8, lines 7-10)

[claim 16] Hyman discloses a method wherein each subject's perceived benefit for each plan design option comprises the sum of the product of the relative weight accorded each statistical factor as defined by the subject's responses multiplied by the value of such statistical factor. (col. 15, lines 59-col. 16, line 58)

[claim 17] Hyman discloses a The method of claim 15 further comprising the step of inputting the identification of a reference plan design option (col. 7, lines 64-col. 8, line 10); and wherein the average perceived benefit for each plan design option is determined by comparing values of the statistical factors relating to such plan design option to the values of the statistical factors relating to the reference plan design option. (col. 9, lines 45-60)

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hyman.

[claims 3-4] Hyman discloses a method for allowing a user to determine the perceived benefit of a plan design option and determining the cost of benefit design options (col. 7, line 64-col. 8, line 10; col. 9, line 56-col. 10, line 4), but does not expressly disclose the units in which this information is expressed (e.g. per-patient per year costs and the average perceived benefit is expressed in terms of per-patient perceived benefit/ or per-member per year costs and per-member perceived benefit.) However, at the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Hyman to express the desired information in per-patient or per-member costs per year and per-member or per-patient perceived benefit format. One would have been motivated to present the information in this manner to facilitate an employer's ability to define and prioritize goals for a benefit plan for employees, as suggested by Hyman. (col. 4, lines 9-29)

8. Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hyman as applied to claim 1 above, and further in view of Warrady (USPN 6,067,522) [claims 5-8] Hyman discloses the method of claim 1, and further discloses a method in which the group members are repeatedly surveyed to determine which whether the employees with opt down or opt out of certain benefits. (i.e. readministering inquiries to the subject group to elicit revised responses comparing each plan design option to the reference plan design option) (col. 7, lines 29-35; lines 54-59). Hyman further discloses

Art Unit: 3626

inputting data representing revised responses of the subject group to the inquiries (col. 7, lines 59-63) and using this revised response data to calculate that average perceived benefit of each design option. (col. 7, lines 64-col. 8, line 6; col. 8, line 60-col. 9, line 25). Hyman does not expressly disclose displaying data representative of the responses to the subject group. Hyman further does not disclose soliciting comments or providing comments from subjects regarding their responses and soliciting comments from subjects regarding the validity of their responses.

Warrady discloses a system and method comprising displaying data representative of the responses to the subject group, soliciting comments or providing comments from subjects regarding their responses and soliciting comments from subjects regarding the validity of their responses. (Figure 5, col. 11, lines 1-19) The employees are given chance to review choices/ selections made regarding benefit plan decisions (in a confirmation) so that the required modifications can be made. At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method/system of Hyman with the teaching of Warrady to display information representative of the subjects' responses and to allow the subjects to respond or provide comments regarding their responses (e.g. the validity of their responses). As suggested by Hyman, one would have been motivated to include these features to permit an employee to repetitively set and reset benefit plan goals and priorities attached to these goals to produce solutions of financial aspects, while allowing the employer to adopt the plan whose financial aspects are also best suited for the employer. (col. 4, lines 12-17)

Response to Arguments

9. Applicant's arguments filed 9/15/06 have been fully considered but they are not persuasive.

(A) Applicant argues that Hyman does not inputting data representative of subject responses in order to calculate average perceived benefit.

In response, Hyman discloses inputting data representative of the subject group responses (col. 5, lines 45-49—e.g. census data from the subject population; col. 6, lines 8-46—e.g. entry of employee statistics; col. 7, lines 29-32). It should be noted from the applicant's language, data representative of (or associated with or reflective of) subject responses is not the same as the actual subject responses.

Moreover, while the Applicant has relied heavily on the calculation of the "perceived benefit," the Applicant has failed to point to and the Examiner was unable to find a definition or equation in the specification for determining calculation. In particular, while Figures 4-6 provide graphs for a "perceived benefit" the x-axis, on which "perceived benefit" is evaluated includes no units of measure. The claim language fails to provide a specific definition for "perceived benefit", which ties the employee statistics, costs, and other demographic data together in any particular manner.

In the absence of such a definition, the Examiner must give the claim language the broadest reasonable interpretation and apply art accordingly. Hyman discloses a method further comprising calculating the average "perceived benefit" for each plan design option (Figure 2B; col. 7, line 64-col. 8, line 10; col. 9, lines 30-48).

Art Unit: 3626

(B) Applicant argues that Hyman does not disclose "an input device capable of receiving data..."

Hyman discloses a system comprising an input device for receiving input data (Figure 1A; col. 5, lines 27-39). It is respectfully submitted that an input device is "capable of receiving" the recited data. Furthermore, it should be noted that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

(C) Applicant argues that Hyman does not disclose "providing the subject group with information about each statistical factor and inquiries to elicit responses...."

In response, the Examiner respectfully disagrees with the Applicant's interpretation of the art. Hyman discloses providing the subject group with information about each statistical factor and inquiries to elicit responses providing the relative weight of each statistical factor to be used in determining the perceived benefit of the plan design options(col. 7, lines 7-19; 29-32)

(D) Applicant argues that there is no motivation to combine Hyman and Warrady and that Warrady teaches away from the modification.

In response, the Examiner respectfully disagrees and submits that Warrady does not teach away from the applied combination. The Warrady reference was relied upon to disclose a system and method comprising displaying data representative of the

Art Unit: 3626

responses to the subject group, soliciting comments or providing comments from subjects regarding their responses and soliciting comments from subjects regarding the validity of their responses. (Figure 5, col. 11, lines 1-19) The employees are given chance to review choices/ selections made regarding benefit plan decisions (in a confirmation) so that the required modifications can be made.

Furthermore in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the applicant has provided motivation from one of the cited references to provide motivation and support the holding of obviousness.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

Art Unit: 3626

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Porter whose telephone number is (571) 272-6775. The examiner can normally be reached on M-F, 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RP

RP


C. LUKE GILLIGAN
PRIMARY EXAMINER
TECHNOLOGY CENTER 3600